

24. An apparatus according to claim 13, wherein:
said requests are made out-of-band.

REMARKS

Claims 1-12 were pending in the application. New claims 13-24 have been added. These new claims are apparatus claims which parallel the method claims 1-12. Claims 1, 2, and 12 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8, and 9 of copending application Serial No. 09/717,999. The Applicant will consider filing a Terminal Disclaimer, if deemed necessary, after agreement has been reached on allowable subject matter.

Claims 1, 2, and 12 stand rejected under 35 U.S.C. §102(b) as anticipated by Gorshe. Claim 1 specifies the following: "[a] method for arbitrating bandwidth in a communications switch, comprising:

- a) generating a repeating data frame having a plurality of rows;
- b) making requests during row N for space in row N+1; and
- c) granting requests through an out-of-band link." [Emphasis added.]

Gorshe discloses communication within a repeating STS-1 frame which is similar to the claimed frame. In the Gorshe system users are preassigned time slots in the STS-1 payload during which they may request access to the overhead part of the STS-1 frame. Thus, any one user will make a request for space during a row N of the frame. However, the request is not a request for space in row N+1. Requests are granted on the expiration of a counter which is set by a number of factors including the amount of traffic preceding the requesting user. Thus, it is unknown, both at the time the request is made and the time that the request is granted, where a requester will be granted space in response to a request. While it might be possible under some circumstance that a request made in row N results in a transmission of data in row N+1, that occurrence would not infringe claim 1 because the request was not for space in row N+1. It was merely a request for some space anywhere.

For the foregoing reasons, claims 1, 2, and 12 (2 and 12 being dependent on claim 1) are not anticipated by Gorshe. It is further submitted that there is nothing in Gorshe to suggest the claim limitations discussed above. Therefore, claims 1, 2, and 12 are not obvious over Gorshe.

Claims 3 and 4 stand rejected under 35 U.S.C. §103 as obvious over Gorshe in view of Chiussi.

The remarks made above regarding claim 1 apply to this rejection as well. In addition, the Examiner has only addressed one limitation of claim 3 and has not addressed the limitation of claim 4.

Claims 5-9 stand rejected under 35 U.S.C. §103 as obvious over Gorshe in view of Chiusi and further in view of Bergantino.

Since all of these claims depend either directly or indirectly from claim 1, the remarks made above regarding Gorshe apply to this rejection as well. Moreover, since claims 8 and 9 contain the same limitations as claims 3 and 4, the remarks made above regarding Chiusi apply to this rejection as well. As to Bergantino, the Examiner cites this reference regarding claims 5 and 6. The stated incentive for combining the references is "in order to meet specific needs." The Examiner does not identify what these needs are nor does he identify where the incentive is found in the prior art. Thus, the Examiner has not made a prima facie case of obviousness.

Claim 11 stands rejected under 35 U.S.C. §103 as obvious over Gorshe in view of Chow et al.

Since Claim 11 depends from claim 1, the remarks made above regarding Gorshe apply to this rejection as well. It is also submitted that the claimed granting requests out-of band when

making requests in-band provides non-obvious results which are described in the specification.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,

A handwritten signature in cursive script, reading "David P. Gordon".

David P. Gordon
Reg. #29,996
Attorney for Applicant(s)

65 Woods End Road
Stamford, CT 06905
(203) 329-1160

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